

**REMARKS**

Claims 1, 2, 5, 6, 11, 12, 14-23, 25, and 26 are all of the claims presently pending in the application. Claim 13 has been canceled without prejudice or disclaimer. Claim 1 has been amended to more particularly define the claimed invention. Claim 16 has been merely editorially amended.

Entry of this Amendment is believed proper since no new issues are being presented to the Examiner that would require further search and/or consideration. Moreover, the amendments to the claims materially reduce the issues on appeal (i.e., by rendering moot the rejections under 35 U.S.C. § 112).

Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1, 2, 5-23, 25, and 26 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement and the enablement requirement. Claim 13 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 13 stands rejected under 35 U.S.C. §112, fourth paragraph, for failing to further specify the claimed invention. Claims 1-2, 5-11, 13-15, 17, 19, 22, 23, 25, and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Kamata et al. (U.S. Pub. No. 2002-0142192; hereinafter “Kamata”). Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kamata in view of Ning et al. (U.S. Pub. No. 2002-0098676; hereinafter Ning). Claim 16 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kamata in view of Baglin et al. (U.S. Pat. No. 6,331,364; hereinafter “Baglin”). Claim 18 stands rejected under 35 U.S.C. §103(a) as being

unpatentable over Kamata. Claims 20-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kamata in view of Chen et al. (U.S. Pat. No. 6,165,803; hereinafter “Chen”).

These rejections are respectfully traversed in the following discussion.

## **I. THE CLAIMED INVENTION**

The claimed invention of exemplary claim 1 is directed to a method of patterning a magnetic thin film. The method includes transforming a portion of the magnetic thin film to be non-magnetic and electrically insulating using a chemical transformation, wherein the portion of the magnetic thin film includes  $\text{Ni}_{0.8}\text{Fe}_{0.2}$  and the transforming includes transforming the  $\text{Ni}_{0.8}\text{Fe}_{0.2}$  to a fluorine-containing film, and wherein the fluorine-containing film is electrically insulating.

## **II. THE REJECTIONS UNDER 35 U.S.C. § 112**

While Applicants maintain that the Examiner’s rejections under 35 U.S.C. § 112 (first, second, and fourth paragraphs) are without merit, merely in an effort to speed prosecution Applicants have amended the claims above.

Specifically, Applicants have amended claim 1 and canceled claim 13. Applicants submit that the amendments to claim 1 and the cancelation of claim 13 render the Examiner’s rejections moot.

### III. THE PRIOR ART BASED REJECTIONS

#### A. The Kamata Reference

Claims 1-2, 5-11, 13-15, 17, 19, 22, 23, 25, and 26 stand rejected under 35 U.S.C. 102(b) as being anticipated by Kamata. Additionally, claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata. Applicants submit, however, that there are features of the claimed invention that are not taught or suggested by Kamata.

That is, Kamata does not teach or suggest “*wherein said portion of said magnetic thin film comprises  $Ni_{0.8}Fe_{0.2}$  and said transforming comprises transforming said  $Ni_{0.8}Fe_{0.2}$  to a fluorine-containing film, and wherein said fluorine-containing film is electrically insulating*”, as recited in exemplary claim 1.

The Examiner attempts to analogize the non-ferromagnetic region 40 of Kamata to the fluorine-containing film of the claimed invention. The Examiner, however, is clearly incorrect.

That is, Kamata merely teaches that the region 40 is non-ferromagnetic. There is no teaching or suggestion in Kamata to support the Examiner’s allegations that the non-ferromagnetic region 40 is insulating.

Therefore, Applicants submit that there are features of the claimed invention that are not taught or suggested by Kamata. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

#### B. The Secondary References

The Examiner alleges that Ning would have been combined with Kamata to teach the claimed invention of claim 12. Moreover, the Examiner alleges Baglin would have

been combined with Kamata to teach the claimed invention of claim 16. Furthermore, the Examiner alleges that Chen would have been combined with Kamata to teach the claimed invention of claims 20 and 21. Applicants submit, however, that, even if combined, the alleged combination of references would not teach or suggest each and every feature of the claimed invention.

That is, Applicants submit that claims 12, 16, 20, and 21 are allowable at least based on similar reasons to those set forth above in section A with respect to claims 1-2, 5-11, 13-15, 17-19, 22, 23, 25, and 26

Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

#### **IV. FORMAL MATTERS AND CONCLUSION**

In accordance with the Examiner's objection to the title, the title has been amended.

In view of the foregoing, Applicants submit that claims 1, 2, 5, 6, 11, 12, 14-23, 25, and 26, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Serial No. 10/680,260  
Docket No. YOR920030013US1  
(YOR.427)

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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: May 27, 2008



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